

REMARKS

Reconsideration of this application in its amended form is respectfully requested.

Claims 1 and 3 have been rewritten as new Claims 21 and 22 in order to overcome the objections as to clarity set forth in the Office Action. In view of the amendments to the claims, it is urged that the several Section 112 rejections have been overcome. Favorable reconsideration and withdrawal of these rejections is respectfully requested.

Hydrogen has been deleted from the definition of the variable "L" in Claims 1 and 3, in order to more clearly distinguish this invention over the prior art. The proviso has also been deleted from Claim 21 (former Claim 1), because the compound recited in the proviso (i.e., Compound C on page 30 of WO 92/06981) is no longer covered by the claim since "hydrogen" has been deleted from the definition of "L".

Claim 9 has been rewritten as new Claim 23. The groups " $C_{1-6}$ alkyloxycarbonyl" and " $C_{1-4}$ alkylcarbonyl" have been deleted from the definition of the variable "Q". In view of this deletion, the proviso has been deleted, since the compound recited in the proviso (i.e., Compound E on page 3 of WO 92/06981) is no longer covered by the claim.

Favorable consideration of the amended claims is respectfully requested.

Applicants note the Examiner's comments with respect to the claims for benefit under 35 U.S.C. 120 of parent applications Serial Nos. 07/714,486 and 07/853,631. While Applicants do not concede the correctness of the Examiner's view that Applicants are not entitled to the benefit of the filing dates of these applications, it is believed that the presently claimed invention is readily distinguishable from the cited WO application. Therefore, Applicants do not need to rely on the filing dates of these applications to remove this citation as prior art, since the subject invention is patentable over the disclosure of said application, as will be demonstrated below.

Claims 21, 22, 4, 11 and 13-14 are rejected under 35 U.S.C. 103 as being unpatentable over Friary, WO 92/06981. This rejection is respectfully traversed, for the reasons that are set forth below.

The Examiner points to Formula 3.0 on pages 8-9 of the reference, which discloses compounds that are taught to be intermediates. When Q in the said Formula 3.0 is CH and  $n = 1$ , some of the species within the genus of the reference's compounds had also been embraced by Applicants' Formula (I) when L in said Formula (I) was hydrogen. It was urged in the Office Action that:

"One having ordinary skill in the art would have been motivated to select the claimed compounds from the genus in the reference since such compounds would have been suggested by the reference as a whole."

With the present amendment to Claim 1 (now Claim 21), L in Formula (I) can no longer be hydrogen. Therefore, no species within Applicants' claimed genus are within the genus of the reference. Since the premise upon which the rejection is predicated is no longer valid, it is urged that the rejection is in error. Accordingly, favorable reconsideration and withdrawal of the rejection of Claims 21, 22, 4, 11 and 13-14 under 35 U.S.C. 103 as being unpatentable over Friary, WO 92/06981, is respectfully requested.

Claim 9 was rejected under 35 U.S.C. 102(a) as being anticipated by Friary, WO 92/06981. In support of this rejection, Formula E on page 3 of the reference was cited. Formula E discloses a compound that would fall within Applicants' Formula (VII) when all the R groups are hydrogen and Q is an N-acetyl group. Claim 9 has been rewritten as new Claim 23 in which the definition for Q has been narrowed to exclude the formerly claimed groups C<sub>1-6</sub>alkyloxycarbonyl and C<sub>1-4</sub>alkylcarbonyl (which include's acetyl). Since the present Claim 23 does not include compounds wherein Q is acetyl, it is urged that the Section 102 rejection is no longer applicable. Favorable reconsideration and withdrawal of this rejection is respectfully requested.

Claim 9 (now Claim 23) is also rejected under 35 U.S.C. 103 as being unpatentable over Friary, WO 92/06981. In support of this rejection, the Office Action points to Formula 1.0 on page 1 of the reference wherein Q is CH,  $n = 1$ , Z is O and  $R^1$  is alkyl or alkoxy. The group  $R^1-(C=Z)-$  of the reference's Formula 1.0 is analogous to Applicants' variable Q in Formula (VII). The present definition of Q in Claim 23 no longer includes alkylcarbonyl or alkyloxycarbonyl, and thus excludes compounds that would be within the genus disclosed by Formula 1.0 of the reference wherein Q is CH,  $n = 1$ , Z is O and  $R^1$  is alkyl or alkoxy.

Applicants' claimed invention is clearly not taught or suggested by the reference. The subject claimed compounds have anti-histaminic activity; the prior art compounds are taught to have PAF (platelet activating factor) antagonist activity. The prior art does not teach any correlation between PAF antagonism and anti-histaminic activity. Therefore, it is respectfully urged that there is no way that the cited art could have suggested the present anti-histaminic compounds.


In view of the present amendment to Formula (VII) in which the variable Q no longer includes within its scope alkylcarbonyl or alkyloxycarbonyl, and in view of the fact that the cited art fails to teach or suggest compounds that have anti-histaminic activity, it is respectfully urged that the cited prior art does not suggest the subject claimed invention. Favorable reconsideration and

JAB 812

withdrawal of the rejection of Claim 23 as being unpatentable under 35 U.S.C. 103 over Friary, WO 92/06981, is respectfully requested.

In view of the foregoing amendments and remarks, it is urged that this application is in condition for allowance. Early favorable action is respectfully requested.

Respectfully submitted,

  
Charles J. Metz  
Attorney for Applicants  
Registration #20,359

Johnson & Johnson  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933

(908) 524-2814

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